IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRIC OF OHIO
EASTERN DIVISION

AARON CLARK, et al.,	:	
	:	
Plaintiffs,	:	
v.	:	**Case No. 2:08CV982**
	:	
THE WALT DISNEY COMPANY, et al.,	:	**Judge Holschuh**
	:	
Defendants.	:	**Magistrate Judge Abel**

PLAINTIFFS AARON CLARK AND JOHN PEIRANO'S MEMORANDUM IN OPPOSITION TO DEFENDANTS' MOTION TO STRIKE DECLARATION OF ELLEN M. SHAPIRO

Now comes Plaintiffs Aaron Clark and John Peirano ("Plaintiffs") by and though undersigned counsel and respectfully submits this Memorandum in Opposition to Defendants JAKKS Pacific, Inc.'s, Play Along Toys and Toys "R" Us' (collectively "Defendants") Motion to Strike Declaration of Ellen M. Shapiro ("Shapiro Declaration") filed by Plaintiffs in Opposition to Defendants' Motion for Summary Judgment. For the reasons set forth in the accompanying Memorandum in Support, Shapiro's Declaration should not be stricken as it is relevant and sufficiently reliable.

Respectfully submitted,

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MEMORANDUM IN SUPPORT

I. INTRODUCTION

Ellen M. Shapiro is a graphic designer and writer. (Doc. 54, Exhibit A, ¶ 1). She holds a B.A. in art with a specialization in design and owns a New York graphic communications business where she concentrates on creating and producing logos, identity systems, publications, advertisements, and marketing communication materials for corporations and nonprofit organizations. *Id.* Shapiro also served as an adjunct professor and lecturer in corporate design, typography, and design presentations at leading design schools and colleges, including Pratt Institute; Parsons School of Design, School of Visual Arts; and Purchase College State University of New York. *Id.* She possesses abundant academic and practical knowledge related to graphic design and is more than qualified by any rational measure to offer the opinions she has tendered. Recognizing that it has no hope of contesting Shapiro's qualifications as a person of ordinary skill in the art and with assisting the jury by explaining and understanding of the importance of the "artistically blends in" limitation of Claims 1 and 5 of the '272 Patent, Defendants attempt to have Shapiro's Declaration stricken as conclusory and based on exclusively unsupported evidence.

Defendants contend Shapiro offers no evidence from the intrinsic record – failing to cite to the claims, the specification, or the prosecution history – to support her claims. (Doc. 56, p. 2). To the contrary Shapiro's Declaration expressly provides:

> 6. As a person of ordinary skill in the art, I have reviewed claims 1 and 5 of the '272 patent, the specification, prosecution history, dictionary definitions of the relevant claim language, and comparable sources, as permitted by the Federal Circuit. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc) ...

> 7. Two such “comparable sources” include the color wheel and various PANTONE® color matching systems, including the Pantone Goe Fan Guide.”[1]

(Doc. 54, Exhibit A, ¶¶ 6-7).

Despite Defendants’ argument, this Court has previously rejected the suggestion made by Defendants that the fact that an expert does not (or cannot) testify to all matters, the expert may not assist the jury with any testimony. *See, Jahn* v. *Equine Svcs.*, 233 F.3d. 382, 390 (6th Cir. 2000) (“…experts are just witnesses, and they need not be purveyors of ultimate truth in order to be allowed on the stand. As the Supreme Court noted in *Daubert* [509 U.S. 579, 113 S.Ct. 2786, 125 L.Ed.2d 469 (1993)], ‘[v]igorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence.’ 509 U.S. at 596, 113 S.Ct. 2786.”); *United States v. Poulsen, et al.*, 543 F.Supp.2d 809, 811 (S.D.Ohio Feb. 8, 2009) (Court noted, in refusing to exclude Defense expert’s testimony that, “Although the jury will not be called upon to directly assess the competence of the Government's investigation, evidence tending to show that the Government failed to follow up on fruitful leads, misinterpreted information in a material way, or employed faulty investigative techniques, could be probative of whether the Government has made its case against Defendants.”). The credibility of Shapiro’s opinions on the claim construction and Defendants infringement of the ‘272 Patent should be left for the fact finder and should not be considered when ruling on Defendants’ Motion to Strike Shapiro’s Declaration.

Shapiro’s analysis of the Infringing Posters, in short, is overwhelmingly well accepted and adequately provides the basis for the proper construction of the housing limitation. Even more, Shapiro’s opinion is uncontested. Defendants argument for non-infringement hinges on their flawed analysis that Claims 1 and 5 "requires that the housing surface be prepared with art that matches the portion of the poster art over which the housing 'artistically blends in' with the surrounding poster." (Doc. 11, pp. 3, 4). The '272 Patent does not limit the "wherein" limitation of Claims 1 and 5 in the manner the Defendants are suggesting. As provided for in Shapiro's analysis of the accused posters, the artwork over the housing unit in each infringing poster clearly meets this limitation in addition to other limitations of Claims 1 and 5. (Doc. 54, Exhibit A, ¶¶15-21 and Appendices F-H).

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[1] Contrary to Defendants’ contentions, the dictionary definitions relied on by Shapiro is attached to Shapiro’s Declaration as Appendix I.

The evidence on which Shapiro relies upon to form her opinions comes from, among other things, her analysis of Defendants' accused posters, the written record of the '272 Patent and acceptable comparable sources. (Doc. 54, Exhibit A, ¶¶2-4, 5, 7-9, 12-21). Shapiro's testimony, which will explain to the jury how the color, finish, and surface artwork of the housing artistically blends and forms a harmonious visual effect with the art on the poster will assist the jury in assessing Defendants infringement of Plaintiffs' '272 Patent. This is no different from, for example, evidence offered of how a prudent treating physician would and should have responded to signs of infection in a patient. *Cf Jahn*, supra.

II. LAW AND ARGUMENT

A. Standard of Review

Evidence is "relevant" if it has "any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." Fed. R. Evid. 401. Relevant evidence "need not conclusively decide the case...but it must in some degree advance the inquiry." *Thompson v. City of Chicago,* 472 F.3d. 444, 453 (7th Cir. 2006). Expert testimony is relevant and admissible where it "will assist the trier of fact to understand the evidence or to determine a fact in issue." Fed. R. Evid. 702. In order to establish the foundation necessary to admit expert evidence, the proponent of the evidence must demonstrate (1) the testimony is based on sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case. *Id.* As provided for above, Shapiro's testimony from the prospective of a graphic designer will explain to the jury how the harmonious effect - the color, finish, and surface artwork of the housing – of the accused posters artistically blends with the art on the surrounding posters, thereby infringing on Plaintiffs' '272 Patent.

Trial judges are to act as "gatekeepers" regarding the admission of expert testimony in order to ensure that it is reliable. *Daubert v. Merrill Dow Pharmaceuticals, Inc.*, supra. There is, however, no *single inquiry* that applies to *every* expert. The "test of reliability is 'flexible: and *Daubert's* list of specific factors neither necessarily nor exclusively applies in every case.'" *Kumho Tire Co., Ltd.* v. *Carmichael,* 526 U.S. 137, 141, 119 S.Ct. 1167, 143 L.Ed.2d 238 (1999). The Supreme Court has emphasized that there is no single method by which an expert's methodology must be evaluated. "We do not believe that Rule 702 creates a schematism that segregates expertise by type while mapping certain kinds of questions to certain kinds of experts. Life and the legal cases that it generates are too complex to warrant so definitive a match." *Id.* at 151. There are "many different kinds of experts and many different kinds of expertise .... [W]e can neither rule out, nor rule in, for all cases and for all time the applicability of the factors mentioned in *Daubert,* nor can we now do so for subsets of cases categorized by expert or by kind of evidence. Too much depends upon the particular circumstances of the particular case at issue." *Id.* at 150 *(citing Daubert,* 509 U.S. at 594). A party proffering expert testimony needs to show by a preponderance of proof that the expert is qualified. *Rose v. Truck*

Centers, Inc., 611 F.Supp.2d 745 (N.D. Ohio 2009).

The threshold inquiry concerning the admission of expert testimony thus rests within the sound discretion of the trial judge. *Gen. Elec. Co. v. Joiner,* 522 U.S. 136, 143, 118 S.Ct. 512, 139 L.Ed.2d 508 (1997). An abuse of discretion standard is applied when reviewing a district court's reliability determination. *Id. See also, Kumho Tire,* 526 U.S. at 142. The trial judge "must have considerable leeway in deciding in a particular case how to go about determining whether particular expert testimony is reliable...The trial court must have the same kind of latitude in deciding how to test an expert's reliability ...." *Kumho Tire,* 526 U.S. at 152. Therefore, as gatekeeper, this Honorable Court has the discretion to determine whether Shapiro, a renowned graphics designer, lecturer, author, professor and patent owner, can aid the jury in understanding the "artistically blends in" limitation in Claims 1 and 5 and Defendants' infringement of Plaintiffs' '272 Patent.

B. Defendants' Criticism of Shapiro's Declaration Lacks Merit

Defendants claim Shapiro's Declaration is "utterly unsupported - and unsupportable – *ipse dixit*" (Doc. 56, p. 2) because Shapiro allegedly failed to identify any reference from the intrinsic record upon which her opinions are based or offer any evidence in demonstrating that an expert would rely on comparable sources such as the color wheel or the PANTONE color matching system. The Supreme Court has emphasized that there is no single method by which an expert's methodology must be evaluated. "We do not believe that Rule 702 creates a schematism that segregates expertise by type while mapping certain kinds of questions to certain kinds of experts. Life and the legal cases that it generates are too complex to warrant so definitive a match." *Kumho Tire,* 526 U.S. at 151. The court must "make sure that an expert, whether basing testimony on professional studies or personal experience, employs in the courtroom the same level of intellectual rigor that characterizes the practice of an expert in the field." *Id.* at 152.

This Honorable Court has before it the uncontroverted testimony of Shapiro. Defendants have maintained that this case is so simple that no expert testimony is required. (Docs. 17, 55). However, when Plaintiffs present a witness, who has professionally designed posters, teaches in the field of corporate design, typography and design presentations, and is an established authority and author of color selection and design art (Doc. 54, Exhibit A, ¶1) and who is fully capable of applying and explaining the basis for the design mechanism which supports the artistic blending limitation of the accused posters (the very basis for which Defendants contest infringement), Defendants diligently seek to strike Shapiro's declaration as being conclusory and inadmissible. Defendants' criticisms of Shapiro's Declaration are meritless. "Experts are permitted a wide latitude in their opinions, including those not based on firsthand knowledge, so long as 'the expert's opinion [has] a reliable basis in the knowledge and experience of the discipline.'" *Jahn,* 233 F.3d at 388 *(quoting, Daubert,* 509 U.S. at 592).

Here, Shapiro is not required, as Defendants suggest, to "demonstrat[e] that a supposed expert would rely on any of these items." (Doc. 56, p. 2). Shapiro's expertise in graphic design and art is sufficient to permit her to form an opinion of Defendants' infringing conduct. Experience-based testimony satisfies *Daubert*'s reliability requirements. *First Tennessee Bank National Association v. Barreto*, 268 F.3d 319, 333 (6th Cir. 2001). Furthermore, despite Defendants' unsupported contentions, the Federal Circuit has noted that "[d]ictionaries or comparable sources are often useful to assist in understanding the commonly understood meaning of words and have been used both by our court and the Supreme Court in claim interpretation." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc); *Exhibit*

Supply Co. v. Ace Patents Corp., 315 U.S. 126, 134, 62 S.Ct. 513, 86 L.Ed. 736 (1942) (relying on dictionaries to construe the claim term "embedded"); *Weber Elec. Co. v. E.H. Freeman Elec. Co.*, 256 U.S. 668, 678, 41 S.Ct. 600, 65 L.Ed. 1162 (1921) (approving circuit court's use of dictionary definitions to define claim terms); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d. 1243, 1247-53 (Fed. Cir. 1998) (approving the use of dictionaries with proper respect for the role of intrinsic evidence). Dictionary definitions have the value of being an unbiased source "accessible to the public in advance of litigation." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996). While seemingly presenting a different argument before this Honorable Court in an attempt to strike Shapiro's Declaration, Defendants have previously acknowledged and found acceptable the use of "dictionaries, [as] a special form of extrinsic evidence, are also useful." (Doc. 11, p. 6).

The Court in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) noted that "dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." *Id.* at 1202. These texts are "objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art," and "deserve no less fealty in the context of claim construction" than in any other area of law. *Id.* at 1203. In *McLean v. 988011 Ontario Ltd.*, 224 F.3d 797, 801 (6th Cir. 2000), the Court stated that "mere 'weaknesses in the factual basis of an expert witness' opinion…bear on the weight of the evidence rather than on its admissibility.'" *McLean*, quoting *United States v. L.E. Cooke Co*, 991 F.2d 336, 342 (6th Cir. 1993). Defendants arguments essentially relate to the factual basis for Shapiro's opinion, *i.e.* the color wheel, dictionary definitions, etc., and even if this Court were to determine that there are weaknesses in the factual basis this still is not grounds for preventing Shapiro from testifying. Here, Shapiro's opinion based on intrinsic evidence, in addition to dictionary definitions and comparable sources, which include the color wheel and various PANTONE® color matching systems[2], is well-accepted, permissible and should not be stricken. Defendants' Motion to Strike is meritless and should be denied.

C. Shapiro is Qualified to Render the Opinions in her Declaration.

Equally flawed is Defendants' contention concerning Shapiro's qualifications as an expert. Defendants' argument rests on the premise that because Shapiro is a graphic designer and writer and lacks a background in engineering or electronics she is not an expert *in the relevant field*. (Doc. 56, p. 4). Even though Defendants have maintained that expert testimony is not needed (Docs. 17, 55), Defendants argue, for the first time, that an expert *in the relevant field* has to have a background in engineering or electronics. (Doc. 56, p. 4). Defendants have always argued that the key limitations in Claims 1 and 5 requires that the housing unit be prepared with the art that matches the portion of the poster art which the housing is placed so that the housing unit "artistically blends in" with the surrounding poster art. (Doc. 11, pp. 1-4, 8, 11; Doc. 55, pp. 2-3, 5-7, 15-17). Never once have Defendants argued non-infringement due from an engineering aspect. Even if for argument sake Shapiro was a "Graphic Art Engineer," she is still a person of ordinary skill in the art who would possess the knowledge to design and implement the color for the housing unit that is in the color scheme or predominant hue of the surrounding poster art. A patentee may prove infringement by any method of analysis that is probative of infringement. *Forest Labs. V. Abbott Labs.*, 239 F.3d 1305, 1312 (Fed. Cir. 2001). Defendants' play on titles does not minimize the fact that Shapiro is highly qualified to be regarded as an expert in this field.

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[2] The Pantone Matching System is a definitive international reference for selecting, specifying, matching and controlling ink colors and has been an industry standard among professional designers for over forty-four (44) years. (Doc. 54, Exhibit A, ¶9).

Defendants have failed to demonstrate and support its argument that a person with a background in engineering or electronics is a person of ordinary skill in the art rendered capable to discuss and understand the "artistically blends in" limitation in Claims 1 and 5. Defendants are unable to do so as the "wherein" limitation of Claims 1 and 5 is understood best by someone with Shapiro's background; that of a graphic designer – NOT one with a background in engineering or electronics. The case law supports and promotes a person of ordinary skill in the art such as Shapiro. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1453 (Fed. Cir. 1984); *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693 (Fed. Cir. 1983). Defendants are incorrect in suggesting that Shapiro is unqualified to testify as a graphic designer. "[T]he rejection of expert testimony is the exception rather than the rule." *In re Air Crash at Lexington, Kentucky, August 27, 2006*, 2008 WL 2954973, 2 (E.D.Ky. 2008), attached hereto as Exhibit "A."

Shapiro has abundant practical, professional and academic qualifications to render her opinion. Shapiro holds a B.A. in art with a specialization in design. (Doc. 54, Exhibit A, ¶ 1). She is the owner of Visual Language LLC, a company that creates and produces logos, identity systems, publications, advertisements, and marketing communications materials for corporations and nonprofit organizations. (Doc. 54, Exhibit A, ¶ 1). Shapiro is so highly regarded that she has served as adjunct professor and lecturer in corporate design, typography, and design presentations at leading design schools and colleges, including Pratt Institute[3]; Parsons School of

[3] "Pratt provides one of the most comprehensive professional art and design educations available, supported by a distinguished faculty and exceptional technical and studio resources" http://www.pratt.edu/academics/art_and_design/

Design, School of Visual Arts[4]; and Purchase College State University of New York.[5] (Doc. 54, Exhibit A, ¶ 1). She also speaks at design conferences in the U.S. and abroad, and has judged design competitions across North America. (Doc. 54, Exhibit A, ¶ 1).

As a design writer, Shapiro has written approximately 100 articles on design education, visual merchandising, retail packaging, corporate and brand identity, typography, illustration, photography, profiles of prominent firms and practitioners in these fields, and industry and cultural trends. (Doc. 54, Exhibit A, ¶ 1). Shapiro's articles on design for the entertainment industry include an article on rock posters for *Step Inside Graphics*, major features in *Print* and *Communication Arts* magazines on design and marketing of the Broadway musicals "Rent" and "Chicago," and a profile of the design department at MTV Networks. (Doc. 54, Exhibit A, ¶ 1). Three of her articles are in current magazines (7/09), including a feature on the Museum of Arts and Design (MAD) in New York City in the current issue of *Etapes*, the international design magazine published in France. (Doc. 54, Exhibit A, ¶ 1).

Shapiro designs and sells a line of educational products to help teach letter recognition, sound-symbol associations, and blending—the fundamentals of reading—to children. Marketed as Alphagram Learning Materials, these products are sold to schools, districts, teachers and parents. (Doc. 54, Exhibit A, ¶ 1). These qualifications give Shapiro unique insight, as a graphic designer, into understanding the "wherein" limitation in Claims 1 and 5 and how the color, finish, and surface artwork of the housing unit on the posters would form a harmonious visual effect with the surrounding art on the poster. Clearly an aesthetic decision was made based on Defendants' belief that the color schemes of the accused posters were chosen to artistically or visually blend it with the surrounding poster artwork. Shapiro's vast experience will aid the jury in understanding why Defendants selected the color scheme it did for the housing units of the accused posters.

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[4] http://www.parsons.edu/

[5] "Princeton Review named Purchase College as one of the "Best 361 Colleges." The College is also included in *America's Best 100 College Buys, the Unofficial Biased Guide to the 328 Most Interesting Colleges*, and it is one of the 151 colleges in the Princeton Review's *Best Northeastern Regional Colleges*." http://www.purchase.edu/aboutpurchase/

Shapiro is qualified by her "knowledge, skill, experience, training or education" to testify as proposed. *See*, Fed.R.Evid. 702. Shapiro is qualified by any rational measure to offer the opinions she has tendered. Shapiro's declaration contains a complete listing of her qualification, both practical and academic, that certainly supports a finding that she is qualified to testify as an expert in this matter. Shapiro's comparison of the claim language of the '272 patent and the accused posters will aid the jury in demonstrating that Defendants' infringing products have each and every claim limitation of the Claims 1 and 5. Defendant's Motion to Strike Shapiro's Declaration, should therefore, be denied.

III. CONCLUSION

WHEREFORE, based on the foregoing, Defendants' Motion to Strike Shapiro's Declaration should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 14, 2009, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system upon counsels of record.

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